

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/727,793
First Named Inventor: John Carney
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL REQUEST FOR REVIEW

Sir:

Review of the final rejection in the above-identified application is requested. No amendments are being filed with this request. The review is requested for the reason(s) stated on the attached sheet(s).

This request is being filed with a notice of appeal.

If there are any additional fees due in connection with this communication, please charge Deposit Account No. 19-3140.

Respectfully submitted,
SONNENSCHNATH & ROSENTHAL LLP

Dated: June 4, 2009

/Tarek N. Fahmi/
Tarek N. Fahmi
Reg. No. 41,402

P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
(650) 798-0300

STATEMENT IN SUPPORT OF PRE-APPEAL REQUEST FOR REVIEW

STATUS OF CLAIMS

Claims 1-47 are presently pending, have been finally rejected, and the subject of this pre-appel request for review.

GROUND OF REJECTIONS TO BE REVIEWED

Claims 1-3, 6-13, 15-19, 22-29, 31-35, 38-45 and 47 stand rejected under 35 USC 103 as being unpatentable over Begeja et al., US PG PUB 2003/0030752 ("Begeja"), in view of Logan et al., US PG PUB 2003/0093790 ("Logan").

Claims 4, 5, 20, 21, 36 and 37 stand rejected under 35 USC 103 as being unpatentable over Begeja in view of Logan and further in view of Shimomura et al., US Patent 6526580 ("Shimomura").

Claims 14, 30 and 46 stand rejected under 35 USC 103 as being unpatentable over Begeja in view of Logan and further in view of Mitchell, US PG PUB 2002/0162120 ("Mitchell").

Review of all of the above grounds of rejection is requested.

ARGUMENT

1. Begeja Fails to Teach or Suggest Automatic Insertion of One or More iTV Application Elements Within a Composite VOD Clip.

Claims 1, 17 and 33 are the independent claims presently pending in this application and each of these claims recites the automatic insertion of interactive television (iTV) application elements *within a composite video-on-demand (VOD) clip* according to characteristics of the component VOD clips that make up the composite VOD clip.

In the Final Office Action, Begeja was characterized as disclosing such features. In

particular, the Office Action states, "Begeja clearly discloses including an interactive element in the composite VOD clip allowing the user to access the longer version of a particular clip ([0025])." Final Office Action mailed March 3, 2009, at p. 2. This conclusion regarding the teaching of the reference is clearly erroneous.

Paragraph [0025] of Begeja reads:

[0025] Once the pertinent segments of the broadcast have been appropriately extracted, for a given user, they can be stitched together for continuous delivery to that user. In this way, for example, the segments can be streamed to the user as a means of providing an easy-to-use delivery methodology for the user, and as a means of conserving bandwidth. Users can view the delivered multimedia asset in its entirety, skip between the assets, or view only portions of the assets, as they desire. Moreover, a user can have access to portions of the original video file that occurred immediately before or after the extracted segments; for example, the user could choose to watch the entire original video file. **Such access can be granted by including a "more" or "complete" button in a user interface.**

Begeja at [0025] (emphasis added).

This passage from the reference is quite clear. Elements (such as user control buttons) are added to a user interface, not to a composite VOD clip. A user interface is not a composite VOD clip (a clip which Begeja characterizes as one that is "stitched together" from pertinent segments of a broadcast). At best, the user interface is a means by which a viewer will view a composite VOD clip. Adding control buttons to a user interface is a very different proposition than adding iTV elements to the clip itself and one does not suggest the other.

2. Because all of the Present Rejections are Based on an Erroneous Conclusion Regarding the Begeja Reference, All of These Rejections Must be Withdrawn.

All of the present rejections rely on the Begeja reference for the teachings discussed above. However, it should now be apparent that such teachings simply do not exist in the reference. If anything, the Begeja reference teaches a clearly different approach than that presently claimed -- namely, adding viewing controls to a user interface rather including iTV

application elements within an actual composite VOD clip. It follows then that claims 1, 17 and 33 (and each of their respective dependent claims) are patentable over Begeja.

Considering the remaining references, Logan is cited for discussing user-defined sequencing of clips, Shimomura is cited for purportedly describing a method of traversing a decision tree, and Mitchell is cited for describing a system that transmits metadata using URLs. Assuming all of these characterizations to be true, it is still the case that none of the references, whether considered independently or in combination with one another and/or with Begeja, teach or suggest the automatic insertion of iTV application elements within a composite VOD clip according to characteristics of the component VOD clips that make up the composite VOD clip, as claimed. Consequently, even if the references were combined in the manner suggested in the Final Office Action, features of the present claims would still be lacking from the combined teachings. Accordingly, all of the present claims are patentable over the combinations of references relied upon in the Final Office Action.

For at least the foregoing reasons, allowance of all of the presently pending claims is respectfully requested.